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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,511	12/27/1999	RUDOLF RITTER	PM 265420	2426

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EXAMINER

HUSEMAN, MARIANNE

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/446,511	Applicant(s) RITTER ET AL.	
	Examiner Marianne Huseman	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 3, 5 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because descriptive labels, other than numerical, are needed for all of the figures. See 37 CFR §1.84(o). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 3, 5 and 18 are objected to because of the following informalities: Claims 3, 5 and 18 do not conform to MPEP § 608.01(n). These claims have not been further treated on their merits. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear as to what is intended to be claimed; i.e., what is meant by the term "sic"?

In claim 17, "documents" should be -- document -- in order to provide proper antecedent basis.

In claim 19, line 2, there is no proper antecedent basis for "the data elements".

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 2, 4, 6 - 17 and 19 - 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 39 - 75 of copending Application No. 09/462,117. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are claiming common subject matter, as follows: A mobile radio telephone network for communicating a transaction to a service provider/merchant using a contactless interface and a mobile telephone/transponder.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4, 6 - 8, 11, 17, 20, and 22 - 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieterse et al in view of Weber et al.

Regarding claims 1, 2, 17 and 23:

Pieterse et al teach a device for transparent interaction between an ic card and a remote terminal such that Applicants' terminal reads on element 42, Applicants' removable id module reads on element 11, Applicants' step of reloading reads on column 10, lines 1-5, Applicants' step of transmitting the customer identification reads on Pieterse et al discussion of mobile telephone, column 9, lines 33 - 36, Applicants' step of checking the authorization reads on column 6, lines 48 - 51 and Applicants' step of charging reads on column 7, lines 1 - 7.

While Pieterse et al do not give the specifics of the terminal, element 42, they do disclose it as possibly being a service provider, column 9, lines 9 - 14. Further, Weber et al teach purchase transactions over a public communication system such that Applicants' step of preparing a transaction document reads on Weber et al's

authorization request and message digest, column 16, lines 9 – 42, Applicants' step of signing reads on column 16, lines 39 – 42, Applicants' step of transmitting reads on column 17, lines 12 – 14, Applicants' step of checking reads on column 17, lines 46 – 47 and Applicants' step of paying into an operator account reads on column 20, lines 24 – 29. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to perform a transaction communication between a service provider/merchant (terminal) and a payment gateway (service center) as taught by Weber et al in the device of Pieterse et al as Pieterse et al do not specify a particular method of doing so, implying that any method would be possible.

Regarding claims 4 and 6:

Weber et al teach the use of SET protocol wherein according to an aspect of the SET protocol, the customer (identification module) sends a digital signature to the merchant who passes it on to the gateway/service center.

Regarding claim 7:

Weber et al teach that the payment gateway is capable of receiving documents in batch mode.

Regarding claims 8, 24 and 25:

While neither Pieterse et al nor Weber et al disclose black lists, a black list is considered to be an old and well-known technique for banks and retailers to keep track of cards (whether they are smart cards, debit cards, wallets or credit cards) that are "bad" (lost or stolen or misused). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize checking "black lists" as money could be lost to everyone legitimately concerned in the transaction.

Regarding claim 11:

Weber et al teach that the client software transmits to the merchant the computer (customer) identity, Weber et al also teach that software can be placed on a smart card. Further, it is considered old and well-known that smart card's usually contain the holder's identity. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to use a smart card as a SIM card.

Regarding claim 20:

Weber et al teach the use of both symmetrical and asymmetrical algorithms.

Regarding claim 26:

Although neither Pieterse et al nor Weber et al specifically teach that their card contains a history (stack), smart cards that keep transaction histories are considered to be old and well-known. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a smart card that will keep a transaction history.

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pieterse et al in view of Weber et al as applied to claim 17 above, and further in view of O'Mahony et al., "Electronic Payment Systems" (hereinafter referred to as O'Mahony et al).

Although neither Pieterse et al nor Weber et al specifically disclose encrypting some transmitted information while not encrypting other transmitted information, O'Mahony et al teach various electronic payment systems wherein it is disclosed that some item information (voucher) transmitted between entities do not need to be encoded while for other items of information (within the same data transmission) are proper to be encoded. See page 81, Section 4.6.4 "CyberCash messages of O'Mahony et al. Therefore, it is considered that it would have been obvious at the time of the invention to save processing time of the receiver of the items of information if only the information requiring privacy from eavesdroppers, etc... were to be encoded and not, for instance, the order information or client/transaction ID.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pieterse et al in view of Weber et al as applied to claims 1 and 2 above, and further in view of Morrill, Jr.

Although Pieterse et al do not specifically teach the use of a smart card communicating via a transponder, Morrill, Jr. discloses a smart card (contactless) wherein a cell phone/transponder is used for smart card communication. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize transponder communication for a smart card as taught by

Morrill, Jr. as the mobile phone of Pieterse et al as they are considered to be interchangeable portable telephone devices.

10. Claims 13 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieterse et al in view of Weber et al as applied to claim 1 above, and further in view of Francini et al.

Although neither Pieterse et al nor Weber et al specifically teach using an integrated inductance in the ic card, Francini et al teach a communication system for communicating with such a card, column 1, lines 7 - 16. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to use an integrated inductance in the ic card of Pieterse et al as it is one of many well-known interchangeable choices for card communication. This is also true of Applicants' infrared communication of claim 15.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Atalla et al, Camp et al, Daggar, Ohki et al, Wilkinson et al, Watanabe, Maes et al, Hurta et al, Kaliski, Jr., Kawan, Joao et al, Zimmerman et al, Matyas, Yacobi, Bowry and Urrows et al were all cited in the co-pending application, 09/462,117.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Application/Control Number: 09/446,511
Art Unit: 3621

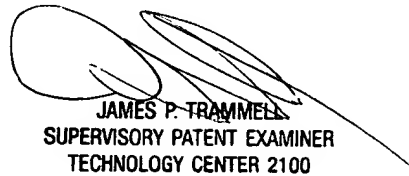
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13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.



Marianne Huseman
Examiner
Art Unit 3621

mh
May 10, 2002



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